



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/740,463	12/22/2003	Pao-Jean Chen	3313-1081P	3610
2292	7590	09/22/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			KNAPP, JUSTIN R	
			ART UNIT	PAPER NUMBER
			2182	
DATE MAILED: 09/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/740,463

Applicant(s)

CHEN, PAO-JEAN

Examiner

Justin Knapp

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Claim 5 claims “an USB module, used to connect to a main host computer to transmit data” and “a control module, used to receive said main host computer’s transmitted data”. There should be step, for example, coupling the USB module with the control module to more clearly show how the control module receives the transmitted data via the USB module that is connected to the host computer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bardmessenger, USPN 5,986,992 in view of Targus Slimline USB External Floppy Drive (herein Targus), http://www.targus.com/us/product_details.asp?sku=PA905U, Wayback Machine date of October 3, 2003.

5. As per claims 1-5, Bardmessenger teaches a method and a disk cartridge and disk drive that comprise a portable storage device used to perform the method as follows:

Looking at Figure 4, Bardmessenger teaches retrieving a remaining data storage capacity about a portable storage device from a main computer host (step S12). The remaining data storage capacity is then stored in a memory on the disk of the portable storage device (step S15). A signal for displaying the remaining storage capacity is given and the remaining storage capacity is displayed (step S16).

Bardmessenger does not explicitly teach wherein the portable storage device utilizes a USB module to connect to a main host computer to transmit data. Bardmessenger does teach that the portable storage device (which again is comprised of a disk drive and disk cartridge) may represent any of a number of types of writable storage technologies including magnetic storage (col 3, lines 24-29). Targus teaches an external portable storage device that utilizes magnetic storage, an external Floppy Drive which utilizes the USB protocol to connect to and communicate with a main host computer (see Product Description). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Bardmessenger with those of Targus. Doing so would provide a portable storage device with hot-plugging capabilities and would be able to communicate with a plurality of computer systems using a well known protocol that would provide increased compatibility.

6. As per claim 6, Bardmessenger in view of Targus teaches a power module used to provide power to the various components of the portable storage device (this is an inherent property of the USB specification to provide power to a USB device). It is also well known in the art to provide a USB compatible device with an independent power source for the device if the device

Art Unit: 2182

can not be fully powered through the USB connection that connects the device to a main host computer.

7. As per claim 7, Bardmessenger in view of Targus teaches an LCD screen (Bardmessenger, col 4, line 67 through col 5, line 4).

8. As per claims 2-4 and 8-10, Bardmessenger in view of Targus teaches wherein said main host computer is a notebook computer (Targus, Features section). It is extremely well known in the art that a desktop computer or a palmtop computer would also be able to act as a host main computer provided it was USB compatible.

Art Unit: 2182

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Knapp whose telephone number is (571)272-4149. The examiner can normally be reached on Mon - Fri 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on (571)272-4083. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Justin Knapp
Examiner
Art Unit 2182

jrk


**KIM HUYNH
PRIMARY EXAMINER**

9/16/05